

### **Remarks**

It is respectfully submitted that Claims 1, 4, 19, 24, and 29 are currently pending. Applicants appreciate the Examiner's acknowledgment of priority, and receipt of the Information Disclosure Statements. In the amendments presented above, Claims 2, 3, 10, 11, 13, 14, 16, and 17 have been canceled. Claim 1 has been amended to claim a particular embodiment of the invention. Applicants assert this amendment presents no issue of new matter, as basis for this amendment can be found in the specification at least on page 14, lines 6-7. Remarks below further address the Office Action dated November 3, 2008.

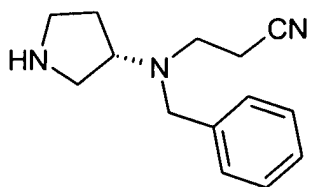
### **Election/Restrictions**

The Applicants acknowledge the Examiner's withdrawal of the restriction requirement set forth in the Office Action dated May 2, 2008.

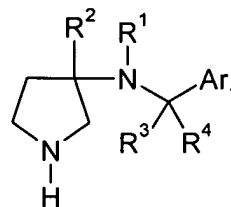
### **Claim Rejections – 35 USC § 102**

The Examiner has rejected Claims 1-4, 19, and 24 as anticipated under 35 U.S.C. § 102 (b) by WO 01/53258 (Yamamoto et al.). The Examiner notes that Yamamoto et al. discloses (3S)-3-[N-(2-cyanoethyl)-N-benzylamino]pyrrolidine (Compound A depicted below).

Applicants respectfully assert that the disclosure in Yamamoto et al. does not anticipate the pending claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Examiner asserts that (3S)-3-[N-(2-cyanoethyl)-N-benzylamino]pyrrolidine anticipates a compound of formula (I), which is depicted below, wherein Ar<sub>1</sub> is phenyl, and R<sup>1</sup> is selected from –CN. Applicants respectfully disagree, as R<sup>1</sup> may not be –CN.



Compound A



(I)

Rather, R<sup>1</sup> is selected from n-propyl, 1-methylethyl, 2-methylpropyl, or 3,3-dimethylpropyl. Thus Yamamoto et al. does not anticipate Claims 1, 4, and 19, and withdrawal of this rejection is respectfully requested.

The Examiner also has rejected Claim 24 as anticipated by the disclosure of (3S)-3-[N-(2-cyanoethyl)-N-benzylamino]pyrrolidine. Applicants assert, however, that Claim 24 is drawn to a pharmaceutical composition comprising a compound of formula 1 of claim 1 *or* 3-[(phenylmethyl)-(3S)-3-pyrrolidinylamino]-propanenitrile, and a pharmaceutically acceptable salt thereof, together with a pharmaceutically acceptable diluent or carrier. Yamamoto et al. describe the use of (3S)-3-[N-(2-cyanoethyl)-N-benzylamino]pyrrolidine as an intermediate in the synthesis of the desired compound in Example 175. There is no disclosure in Yamamoto et al. of the use of (3S)-3-[N-(2-cyanoethyl)-N-benzylamino]pyrrolidine as a pharmaceutical composition. Because Yamamoto et al. does not disclose a every element of the invention encompassed in Claim 24, Applicants assert that Claim 24 is not anticipated, and respectfully request withdrawal of the rejection.

#### **Claim Rejections – 35 U.S.C. § 103**

The Examiner has rejected Claim 29 as obvious over of Yamamoto et al., and further in view of Hertel et al. Applicants submit that Claim 29 is not obvious in view of these references.

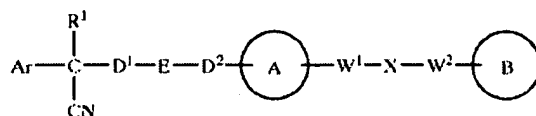
Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) describes the factual inquiries that applicable in determining obviousness and they are as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Applicants further address the Examiner's allegations in view of these factors below.

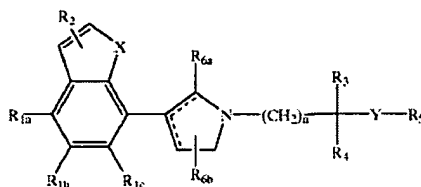
#### *Scope and Content of the Prior Art and Differences between the Prior Art and Claims at Issue*

Yamamoto et al. provides the following formula:



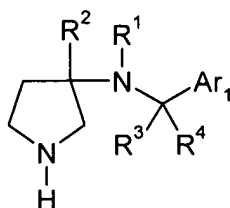
wherein any compounds encompassed therein are required to possess cyclic moieties Ar, A, and B, and a cyano substituent as depicted above.

Hertel et al. disclose fused heterocyclic compounds of the following formula:



and various potential uses thereof. In particular, Hertel et al. disclose that the compounds described therein are useful as serotonin reuptake inhibitors.

Regarding the present invention, Claim 29 encompasses a method for treating (ADHD), comprising administering to a patient in need thereof an effective amount of a compound of claim 1 which selectively inhibits the reuptake of norepinephrine over serotonin and dopamine, or a pharmaceutically acceptable salt thereof. Claim 1 encompasses compounds of formula I:



(I).

### *Lack of rationale and motivation for a Finding of Prima Facie Obviousness*

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the

claim limitations. MPEP §2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Foremost, Applicants note that the compounds disclosed as potentially useful in the treatment of various disorders in Yamamoto et al. are vastly different from the compounds of the present invention. The Examiner has offered no evidence for why the skilled artisan would be motivated to modify the polycyclic cyano-containing compounds of Yamaoto et al. to arrive at the aminopyrrolidine compounds of the present invention, and certainly has not provided evidence for the motivation to use those compounds in the treatment of ADHD. The Examiner's assertion that the different diseases cited by Yamamoto et al. direct the skilled artisan to treat ADHD with the novel compounds of claim 1 is not well-taken, as Yamamoto et al. do not disclose any mention of the disorder ADHD. Further, there is nothing provided to support the allegation that the skilled artisan would have a reasonable expectation of success that compounds structurally dissimilar to those described in Yamamoto et al. would treat a disease that is *not described* in Yamamoto et al. Because the skilled artisan would not be motivated by Yamamoto et al. to utilize the compounds of claim 1 to treat ADHD with a reasonable expectation of success, Applicants maintain that claim 29 is not *prima facie* obvious in view of Yamamoto et al.

The Examiner also appears to assert that Claim 29 would be *prima facie* obvious over Yamamoto et al. in view of Hertel et al. Applicants have addressed various distinctions between the presently claimed invention and Yamamoto et al. above. Hertel et al. and its disclosure of fused heterocyclic compounds said to be useful for the treatment of various disorder provides no additional teaching to direct the skilled artisan to the claimed invention. The Examiner has provided no indication for why the skilled artisan would be motivated to a) combine the teachings of Hertel et al. and Yamamoto et al. b) to arrive at aminopyrrolidine compounds of formula (I), especially in view of the fused heterocyclic compounds disclosed in Hertel et al., c) with a reasonable expectation of success that those compounds would be useful in the treatment of ADHD. As such, Applicants submit that a *prima facie* case of obviousness over Yamamoto et al., or over Yamamoto et al. in view of Hertel has not been established. Withdrawal of this rejection is respectfully requested.

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Applicants respectfully request entry of the above amendments, and allowance of the amended claims in view of the arguments presented above. Should the Examiner have any questions the Examiner is invited to contact the undersigned at the telephone number provided below.

Respectfully submitted,

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